

Attorney's Docket: 2003DE117Serial No.: 10/533,475Group: 1713Response to Office Action Mailed 08/30/2007

REMARKS

The Office Action mailed August 30, 2007, has been carefully considered together with the reference cited therein. The amendments and remarks presented herein are believed to be fully responsive to the Office Action. The amendments made herein are fully supported by the Application as originally filed. No new matter has been added. Accordingly, reconsideration of the present Application in view of the above amendments and following remarks is respectfully requested.

CLAIM STATUS

Claims 1-7 and 9-13 are pending in this Application. By this Amendment, Applicants have amended claims 1, 10 and 11, and canceled claim 6. Applicants have amended claims 1, 10 and 11 to recite that the polyolefin wax consists of a homopolymer of propylene, or a copolymer of propylene and another olefin selected from the group consisting of ethylene, a branched or unbranched 1-alkene having 4 to 20 carbon atoms, and mixtures thereof, or a copolymer of ethylene and a branched or unbranched 1-alkene having 4 to 20 carbon atoms and that the at least one polyolefin wax is without polar modification. Support for the amendments to claims 1, 10, and 11 may be found in originally filed claims 1, 4, 5, and 7, and in Applicant's Specification at page 11, line 25, respectively. The claims under consideration, therefore, include claims 1-5, 7 and 9-13. It is believed that no new matter has been introduced by this amendment.

Claim Rejections under 112

Claims 1-7 and 9-13 were rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement for not having support for the recitation that the at least one polyolefin wax is without polar modification is not proper and should be withdrawn. In Applicant's Specification at page 11, line 25, the Specification states:

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"For preparing the hotmelt adhesives of the invention it is possible to use metallocene polyolefin waxes without modification or with polar modification."

Therefore, the rejection of claims 1, 10, and 11, as amended and their dependencies claims 2-7, 9 and 13 under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement for not having support for the recitation that the at least one polyolefin wax is without polar modification is not proper and should be withdrawn in view of Applicant's Amendment which is clearly support by Applicant's Specification.

Claim Rejections Under 35 USC § 103(a)

The rejections of Claims 1-5, 7-13 under 35 USC § 102(b) as being anticipated by, or, in the alternative, under 35 USC § 103(a), as being obvious over Hohner (US 5,998,547) and the rejection of Claim 6 under 35 U.S.C. 103(a) as obvious over Hohner (US 5,998,547) were initially withdrawn, but these were reinstated in view of the above 112 rejection. Applicant' requests that the rejection of Claims 1-5, 7-13 under 35 USC § 102(b) as being anticipated by, or, in the alternative, under 35 USC § 103(a), as being obvious over Hohner (US 5,998,547) and the rejection of Claim 6 under 35 U.S.C. 103(a) as obvious over Hohner (US 5,998,547) again be withdrawn in view of the amendments to claims 1, 10 and 11, which should overcome the 112 rejection and make these rejections moot in view of arguments filed in Applicant's response filed 27 June, 2007. This rejection is respectfully overcome.

Claims 1-5, 7, 9-13 were rejected under 35 U.S.C. 102(b) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over Chang (US 4,914,253). The rejection of claim 1 as amended under 35 U.S.C. 102(b) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over Chang (US 4,914,253) should be withdrawn for the reason that Chang does not disclose all of the elements of Applicant's invention, and for the reason that no one with ordinary skill in the art would have any incentive to modify Chang to arrive at the instantly claimed

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invention. Chang discloses a composition comprising polyethylene waxes prepared using metallocene catalysts and discloses the thus produced polyethylene waxes in hot melt adhesives. There is no motivation in Chang to employ any other type of polyolefin wax produced by reaction in the presence of a metallocene catalyst, and it is well known that physical properties of materials produced by the use of the catalytic arts are unpredictable. Furthermore, Applicant has disclosed in Applicant's Table 2, on page 15 of Applicant's originally filed Specification that for the Inventive Examples 2, 3, and 4 wherein the polyolefin wax was based on homopolymers of propylene and copolymers of propylene and other linear olefins produced in the presence of a metallocene catalyst, that the resulting polyolefin waxes exhibited generally higher bond strengths and predominantly better low-temperature flexibility than polyethylene waxes as exemplified by Inventive Example 1 which was based on a homopolymer of ethylene.

Wax Used	R&B Softening Point °C	Viscosity at 180 °C mPa.s	Bond Strength N/mm	Low Temperature Flexibility °C
Inventive Ex 1	91	1700	0.8	-5
Inventive Ex 2	87	3300	1.2	-10
Inventive Ex 3	84	3400	1.4	-15
Inventive Ex 4	85	2200	1.3	10

Therefore the rejection of claim 1, as amended under 35 U.S.C. 102(b) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over Chang (US 4,914,253) should be withdrawn for the reason that Chang's disclosure is limited to homopolymers of ethylene, and for the reason that no one skilled in the art would have any expectation of success in modifying Chang to any other polymer based on different olefins for the reason that it is well accepted that the catalytic arts are unpredictable and no one skilled in the art would have been able to predict the physical properties of polymers by altering the selection of starting monomers, particularly in view of Applicant's showing of the unexpected advantages of

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polyolefin waxes based on polymers other than homopolymers of ethylene. The rejection of independent claims 10, 11, and dependent claims 2-5, 7, 9 and 12-13 under 35 U.S.C. 102(b) as anticipated by, or in the alternative, under 35 U.S.C. 103(a) as obvious over Chang (US 4,914,253) should be withdrawn for the reasons given in support of amended claim 1.

Claims 1-5, 7, 9-13 were rejected under 35 U.S.C. 103(a) as being obvious over Hohner (US 5,998,547) in view of Chang (US 4,914,253). The Office will note that independent claims 1, 10 and 11 have been amended to recite that the polyolefin wax or the polyolefin waxes are without polar modification.

An examination of Hohner indicates that such reference is specifically directed to waxes modified so as to be polar. See, *inter alia*, Abstract, column 1, lines 55-59; column 2, lines 1-3; column 3, lines 35-36; the examples in columns 3-6 and claim 1 in column 5. Thus, Hohner teaches away from Applicant's invention which now specifically recites that the polyolefin waxes are without polar modification. Clearly, it is Applicants' courteous position that one with ordinary skill in the art would not have any incentive to modify Hohner to arrive at the instantly claimed invention. In contrast, the ordinary artisan having knowledge of Hohner would have an express disincentive to modify Hohner in a manner that would allow arrival at the claimed invention. The reason for this, simply put, is that Hohner specifically, and only, teaches waxes that are modified to be polar. An artisan, having ordinary skill, would first necessarily have to abandon the express teachings of Hohner to arrive at the instantly claimed invention, and thus, has an express disincentive to do so. In consequence, it is respectfully contended that Hohner can not make the present invention obvious as the requisite motivation is entirely lacking. As discussed herein above, Chang's disclosure is limited to homopolymers of ethylene, and no one skilled in the art would have any expectation of success in modifying Chang to any other polymer based on different homopolymers or different copolymers of different olefins for the reason that it is well accepted that the catalytic arts are unpredictable and for the reason that no one skilled in the art would have been able to predict the physical properties of polymers prepared in a catalytic

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reaction by altering the selection of the starting monomers, and more particularly no one skilled in the art would be able to predict Applicant's showing of the unexpected advantages of polyolefin waxes based on polymers or copolymers other than homopolymers of ethylene. No combination of Hohner and Chang would result in Applicant's invention. Furthermore, any motivation found by the Office necessary to substantiate its § 103 rejection is, in Applicants' courteous opinion, the product of impermissible hindsight gained by a knowledge of Applicants' disclosure. Therefore, the rejection of claim 1 as amended under 35 U.S.C. 103(a) as being obvious over Hohner (US 5,998,547) in view of Chang (US 4,914,253) should be withdrawn for the reasons given hereinabove. The rejection of independent claims 10 and 11, and their dependent claims 2-5, 7, 9, and 12-13 under 35 U.S.C. 103(a) as being obvious over Hohner (US 5,998,547) in view of Chang (US 4,914,253) should be withdrawn for the reasons given in support of amended claim 1.

In view of the foregoing, it is respectfully contended that the 35 USC § 112, USC § 102, and 35 USC § 103 rejections have been overcome. In consequence, Applicants respectfully solicit reconsideration and withdrawal of the rejections.

In view of the forgoing amendments and remarks, the Application is believed to be in condition for allowance, and reconsideration of it is requested. If the Examiner disagrees, he is requested to contact the attorney for Applicants at the telephone number provided below.

Respectfully submitted,



Richard P. Silverman
Agent for Applicant
Registration No. 36,277

(CUSTOMER NUMBER 25,255)

Clariant Corporation
Industrial Property Department
4000 Monroe Road
Charlotte, North Carolina 28205
Phone: (704) 331-7156
Fax: (704) 331-7707